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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,450	04/14/2000	Syed Zaem Hosain	02556.P033X	8921

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EXAMINER

SHARMA, SUJATHA R

ART UNIT

PAPER NUMBER

2682

DATE MAILED: 12/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/549,450

Applicant(s)

HOSAIN ET AL.

Examiner

Sujatha Sharma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans [US 6,311,060] in view of Roach [US 6,044,265].

Regarding claims 1,2,4,5,9,10,13-15,18,21-23,25 Evans discloses a method and an RF module comprising of a processor and memory for sending a beacon page request and determining whether a particular service is provided by a cellular provider by listening for a page in a first frequency block and if the page is not heard in a specified period of time switches to a second frequency and listens to the page in the second frequency and determining that the service is provided in the said frequency block when the said page is sensed. Evans however is silent about associating the system identification with a number plan area code (NPA). See abstract, summary of invention, Fig. 3, Fig. 9, column 32, lines 28-41 and column 36, lines 14-67 Roach teaches a method of identifying the system identification (SID) by a NPA. Roach further teaches the method of updating the SID table after a page is sensed in the said frequency block. See column 4, lines 13-44.

Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to provide the above teachings of Roach to Evans in order for an easy updating SID and informing the cellular set to add or remove the SIDs to the list.

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Regarding claims 3,12,16,20,24 Evans further discloses the method of listening to the page in the first frequency block for a pre-determined amount of time and switching to second frequency block if a page is not sensed in the first frequency block. See abstract, summary of invention, Fig. 9 and column 35, lines 31-58.

Regarding claim 6, Evans further discloses a method of transmitting a coverage determination packet requesting a page in the first frequency block. See column 34, lines 14-23.

Regarding claims 7,8,11,19 Evans further discloses a method of listening to the page for a pre-determined amount of time and determining if a particular service is provided in the first frequency block. See Fig.9, column 36, lines 14-67.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 26-34 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 of co pending Application No. 09/425,485. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 35-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-21 of co pending Application No. 09/425,485. Although the conflicting claims are not identical, they are not patentably distinct from each other because the "RF module comprising of memory" recited in claim 13 of the co pending application 09/425,485 suggests "machine accessible medium" and the claim "memory accessed by the processor" in the co-pending application 09/425,485 suggests "the machine accessible medium accessed by a machine".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Seaholtz [US 5,790,952] discloses a beacon system using cellular digital packet data communication for roaming cellular stations.

English [US 5,870,674] discloses a method and apparatus for performing preferred system selection.

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Blakeney [US 6,466,802] discloses a method and apparatus for performing preferred system selection.

Seppanen [US 5,903,832] discloses a mobile terminal having enhanced system selection capability.

Haberman [US 5,613,204] discloses a beacon system for roaming cellular stations.


Bamburak [US 5,905,955] discloses a method for selecting a wireless service provider in a multi-service provider environment using a geographic database.


Zicker [US 5,159,625] discloses a method of selecting the cellular system with which a cellular mobile radiotelephone communicates.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sujatha Sharma whose telephone number is 703-305-5298. The examiner can normally be reached on Mon-Fri 7.30am - 4.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone numbers for the organization where this application or proceeding is assigned and for all official communications is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.


Sujatha Sharma
December 17, 2002


VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
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